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10/596,582	11/16/2006	Shaun Puckrin	356952.00051-US	8048
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Saul Ewing LLP (Philadelphia)			CHOY, PAN G	
Attn: Patent Docket Clerk				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,582	Applicant(s) PUCKRIN, SHAUN	
	Examiner PAN CHOY	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 and 19-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-18 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. This **FINAL** Office Action is in response to communications received on July 13, 2009. Claims 1, 3, 11 and 15 have been amended; Claims 8-10 and 19-23 have been cancelled; claim 24 has been added.

Currently claims 1-7, 11-18 and 24 are pending.

Response to Amendment

2. Applicant's amendment to claims 21-23 are **sufficient to overcome the claim objections** as set forth in the previous office action.

Applicant's amendment to claim 23 is **sufficient to overcome the 35 U.S.C. § 101 rejections** as set forth in the previous office action.

Response to Arguments

3. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-5, 11-18 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over (U.S. Pub. No.: 2003/0036914) to Fitzpatrick et al., (hereinafter: "Fitzpatrick"), and in view of (U.S. Pat. No.: 6480831) to Cordery et al., (hereinafter: "Cordery").

Regarding Claim 1, Fitzpatrick discloses a method of operating a computing device (see Abstract and ¶ 6: computing devices) which enables the communication of information between the device (see Abstract, Fig. 1, and ¶ 7: *first computing device*) and a further computing device (see Abstract, Fig. 1, and ¶ 7: *second computing device*), each having a communications capability (see ¶ 7: *receiving communication; local communication, or wireless communication*; and ¶¶ 23-25), the method comprising causing the device to request information regarding contact entries in a contact store of the further device (see ¶ 29: *search the contact lists corresponding to each person identified in message 225 for common contacts*; and ¶ 4) and for a hash key to be transmitted to the further device, causing the devices each to generate digests of contact entries in their respective contact stores using the hash key and for the digests

Art Unit: 3624

generated by the further device to be transmitted to the device, using the digests to compare the contact entries of the respective contact stores and notifying at least one of the devices of contacts determined to be common to the contact stores of the devices (see ¶ 8: *the second computing device can provide notification to the second user that another user has at least one common contact, and the first computing device can provide notification to the first user that another user has at least one common contract*).

Fitzpatrick does not specifically disclose a hash key to be transmitted to the further device, causing the devices each to generate digests of contact entries in their respective contact stores using the hash key and for the digests generated by the further device to be transmitted to the device, using the digests to compare the contact entries of the respective contact stores; however, Cordery in an analogous art of “Method and apparatus for securely transmitting keys from a postage metering apparatus to a remote data center” teaches “creating a hash key and sending the hash and the key from the first device to the second device” (col. 2, lines 18 -27), “the hash function processor 230 generates a message digest of selected data, at step S19 the message digest is then encrypted utilizing the private key 246 and the encryption engine 228” (see col. 3, lines 57- col. 4, lines 67); and “the data center compares its generated hash value to the received hash value” (col. 5, lines 14-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Cordery in the system of Fitzpatrick, since the claimed invention is merely a combination of old elements, and in the combination each element merely

Art Unit: 3624

would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claim 2, Fitzpatrick discloses the method of claim 1, wherein the contact store of the device and/or the contact store of the further device is/are arranged as a plurality of overlapping or exclusive groups of contact entries (see ¶ 38: *a person's contact list can be marked private or non-public*).

Regarding Claim 3, Fitzpatrick discloses the method of claim 2, wherein contact entries in the contact store of the device and/or the contact store of the further device are selectively excluded from the comparison of contact entries (see ¶ 38: *the contact marked as private or non-public would not be compared to another's contact list in determination of common contacts*).

Regarding Claim 4, Fitzpatrick discloses the method of claim 3, wherein at least one of the groups is selectively excluded from the comparison of contact entries (see ¶ 38: *a contact marked as private or non-public would not be compared to another's contact list in determination of common contacts*).

Regarding Claim 5, Fitzpatrick discloses the method of claim 1, wherein the contact entries are selected to comprise telephone numbers (see ¶ 29: *the contact clearing house can compare additional features such as telephone numbers*).

Regarding Claim 11, Fitzpatrick does not specifically disclose the method of claim 1, wherein a network server is arranged to generate the hash key and communicate it to the devices; however, Cordery teaches “creating a hash key and sending the hash and the key from the first device to the second device” (col. 2, lines 18 -27). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Cordery in the system of Fitzpatrick, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claim 12, Fitzpatrick discloses the method of claim 1, wherein the comparison of contact entries is undertaken by one of the computing devices using data communicated to it by the other (see ¶ 35: *each PCD can include a computer program for sending and receiving another person’s contact information as well as for comparing that information to locally stored contact information*).

Regarding Claim 13, Fitzpatrick discloses the method of claim 1, wherein the comparison of contact entries is undertaken by a network server (see ¶ 20: *the contact clearing house can be implemented as one or more computer programs existing within a computer system (server); and ¶ 29: the contact clearing house can receive the message and search the contact lists corresponding to each person identified in the message for common contacts, and the corresponding contact list can be compared*).

Art Unit: 3624

The contact clearing house can compare additional features such as the contact category, i.e., business or personal, address, e-mail address, telephone numbers, and the like).

Regarding Claim 14, Fitzpatrick discloses the method of claim 1, wherein the contacts store accessible by the device and the contacts store accessible by the further device are held respectively on the device and the further device (see ¶ 21: *The contact clearing house can include contact information corresponding to participating users, the contact information can be stored electronically in the form of contact list uploaded from the Portable Computing Devices*).

Regarding Claim 15, Fitzpatrick discloses the method of claim 1, wherein the contacts store of the device and the contacts store of the further device are held by a third party (see ¶ 21: *The contact clearing house can be operated by a trusted third party to ensure data integrity and accuracy*).

Regarding Claim 16, Fitzpatrick discloses the method of claim 15, wherein the third party comprises the network server (see ¶ 20: *the contact clearing house can be implemented as one or more computer programs existing within a computer system*).

Regarding Claim 17, Fitzpatrick discloses the method of claim 1, wherein communication between the device and further device occurs over a wireless link (see ¶ 7: *communication can be a wireless communication*).

Regarding Claim 18, Fitzpatrick discloses the method of claim 17, wherein the wireless link comprises any one or more of a cellular phone network, infrared, Bluetooth or a 802.11 WiFi network (see ¶ 7: *a infrared wireless communication, satellite or cellular*; ¶ 20: *a non-local wireless communications link such as cellular or a satellite communication link*).

Regarding Claim 24, Fitzpatrick discloses a computing device (see Abstract and ¶ 6: computing devices) having a communications capability (see ¶ 7: *receiving communication; local communication, or wireless communication*; and ¶¶ 23-25) and a contacts store (¶ 7: *a data store, which can include contact information*), the device being configured to request information regarding contact entries in a contact store of a further device and for a hash key to be transmitted to the further device (see ¶ 29: *search the contact lists corresponding to each person identified in message 225 for common contacts*; and ¶ 4), means to generate digests of contact entries in the contact store of the device using the hash key and using the digests to compare contact entries of its contact store with contact entries of the contacts store of the further device, and notifying at the further device of contacts determined to be common to the contact stores of the devices (see ¶ 8: *the second computing device can provide notification to the second user that another user has at least one common contact, and the first computing device can provide notification to the first user that another user has at least one common contract*).

Fitzpatrick does not specifically disclose means to generate digests of contact entries in the contact store of the device using the hash key and using the digests to

Art Unit: 3624

compare contact entries of its contact store with contact entries of the contacts store of the further device; however, Cordery teaches “the hash function processor 230 generates a message digest of selected data; at step S19 the message digest is then encrypted utilizing the private key 246 and the encryption engine 228” (see col. 3, lines 57- col. 4, lines 67); and “the data center compares its generated hash value to the received hash value” (col. 5, lines 14-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Cordery in the system of Fitzpatrick, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

6. **Claims 6-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick and in view of Cordery as applied to claim 1 above, and further in view of (U.S. Pat. No.: 44390981 A) to Wood et al., (hereinafter: “Wood”).

Regarding Claim 6, Fitzpatrick does not specifically disclose the method of claim 5, wherein selected characters are removed from the telephone numbers; however, Wood in an analogous art of “Microprocessor controlled message handling system” teaches “a phone number may be typed with interspersed non-digit characters, these characters are removed from the number, and do not appear when the phone number is displayed” (see col. 14, lines 63-66). It would have been obvious

Art Unit: 3624

to one of ordinary skill in the art at the time of the invention to include the features as taught by Wood in the system of Fitzpatrick, and in view of Cordery, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claim 7, Fitzpatrick does not specifically disclose the method of claim 6, wherein the telephone numbers are arranged to comprise a country or area code; however, Wood discloses a local phone number (408) 736-7320 including area code (408) (see col. 14, line 67). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Wood in the system of Fitzpatrick, and in view of Cordery, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Burr (U.S. Pat. No.: 7177594 B2) discloses a method of establishing a mobile ad hoc network between a plurality of wireless mobile device that have common contacts on their contact lists, determining mutual common contacts

Art Unit: 3624

of the predetermined contact lists, and enabling a request for communicate over a telephone network.

- Rouse et al., (U.S. Pub. No.: 2002/0087620 A1) discloses a system and method for communication between mobile devices and enabling user to access information using mobile device over wireless data networks.
- Match-Maker for Mobile Phone, FTXT.com, M2 Presswire, Coventry, August 1, 2002; discloses an easy and convenient way of meeting new people by using mobile phones.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pan Choy whose telephone number is (571) 270-7038. The examiner can normally be reached on Mon-Fri, 8:30AM - 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PAN G CHOY/
Examiner, Art Unit 3624
November 16, 2009

/Romain Jeanty/
Primary Examiner, Art Unit 3624